

### **REMARKS**

The Office Action mailed 28 January 2008 has been received and reviewed. Each of claims 1-21, 23-54, 56-66, 80-120, and 135-148 stands rejected. Claims 1, 34, 80, 93, 107, and 135 are amended, and claims 17-18, 32-33, 50-51, 63, 85-86, 90, 99, 103, 111-112, 137-143, and 145 are canceled. Reconsideration of the present application in view of the following remarks and above amendments is respectfully requested.

### **Substance of Interview**

Applicant thanks examiner Avellino for granting the interview on 18 March 2008 and for considering the remarks regarding independent claims (1, 34, 80, 93, 107, and 135) and the arguments regarding the use of "Official Notice," and the deficiencies of the prior art, including Buxton, Kim, Lockridge, Rodriguez, Simec, and Nomura. During the interview, the examiner said further consideration of the independent claims is required and a revised Final rejection may be issued to clarify the Office's application of the prior art.

### **Official Notice**

The Office finalizes allegations that assertions of Official Notice without an affidavit or any other form of concrete evidence are established conclusively and irrebutably as admitted prior art for the rest of the prosecution of this application because a "seasonable challenge" of the assertions were not made. Final Office Action mailed 28 January 2008 at pp. 15-16. Applicant respectfully disagrees with the Office's interpretation and application of MPEP §2144.03 because the relevant case law and patent rules require the Office to provide concrete evidence, including citations to references or affidavits, with respect to core factual findings. Applicant respectfully reminds the Office that the Manual of Patent Examination Procedure (MPEP) does not have the force of law or the force of rule, i.e., Title 37 of the Code of Federal

Regulations. See, *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F. 2d 1423, 1439, 221 U.S.P.Q. (BNA) 97, 107 (Fed. Cir. 1984); and *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 (Fed. Cir. 1995).

Recent decisions regarding the proper use and scope of Official Notice illustrates “facts” must be supported by “substantial” evidence, which means that facts must be supported concrete evidentiary support. In August 2001, the Federal Circuit decided *In re Zurko* and held “[w]ith respect to core factual findings in a determination of patentability, [the Office] cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the [Office] must point to some concrete evidence in the record in support of these findings.” *In re Zurko*, 258 F.3d 1379, 1385-1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See, also, 37 CFR 1.104(d)(2).

Contrary to the Office’s assertions, at pp. 15-16 of the Final Office Action, the *In re Chevenard* court does not announce or endorse a time limitation for challenging the Office’s assertion of Official Notice. *In re Chevenard*, 139 F.2d 711 60 U.S.P.Q. (BNA) 239 (C.C.P.A. 1943). Instead, the Court of Claims and Patent Appeals merely finds that a statement that was not challenged before the Patent Office may have been challenged under the rules of the Patent Office. Further, the Court noted that a challenge may have required an affidavit of the examiner supporting such statement. *Id.* Accordingly, the Office’s citation to *Chevenard* does not support a requirement for a “seasonable challenge.” Moreover, the patent rules, i.e., 37 C.F.R. 1.04(d)(2), does not impose a time limit for challenging the Office’s assertion of Official Notice during prosecution of a patent application. Further, 37 C.F.R. 1.104(c)(2) requires the Office to provide citations to reference when denying patentability of any invention. Here, the relevant

case law and relevant rules do not place a time limit for challenging the Office's use of Official Notice but requires a clear and complete rejecting of each claim pending in the application.

Accordingly, Applicant hereby requests the Office to provide substantial evidence to support its factual findings and reasserts the 10 December 2007 challenges made against the Office's statements of Official Notice with respect to claims 2, 3, 9, and 10-13.

At the time of Applicant's invention of claim 2, it was not well-known in the art that distributable content configured to expire was communicated to a collection engine from a content provider across the Internet in response to a subscriber's request. Instead, content distributed across the Internet was sent directly to the subscriber and was not configured to expire or was not communicate to a collection engine.

At the time of Applicant's invention of claim 3, it was not well-known in the art that distributable content configured to expire was communicated to a collection engine at a digital subscriber line access multiplexer from a content provider across a first network in response to a subscriber's request. Instead, content distributed across the first network in response to subscriber request was sent directly to the subscriber and was not configured to expire.

At the time of Applicant's invention of claim 9, it was not well-known in the art that distributable content configured to expire was transmitted from a content storage over a local wireless interface to a subscriber. Instead, content distributed across the network in response to subscriber request was sent directly to the subscriber without traversing a local wireless network.

At the time of Applicant's invention of claims 10-13, it was not well-known in the art that distributable content configured to expire was communicated to a collection engine at a central telephone office or optical head end from a content provider across a first network in

response to a subscriber's request. Further it was not well known to further distribute the content over the second network. Instead, content distributed across the first network in response to subscriber request was sent directly to the subscriber from the content provider and was not communicated to the subscriber over a second network.

Because Applicant traverses each statement Official Notice, Applicant requests other evidence to support the Office's assertion that the claimed elements of claims 2, 3, 9, and 10-13 are well-known in the art.

**Rejections based on 35 U.S.C. § 103(a)**

A.) Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See *Application of Bergel*, 292 F. 2d 955, 956-957 (CCPA 1961). Recently, the Supreme Court elaborated, at pages 13-14 of the *KSR* opinion, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art

references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, No. 04-1350, 550 U.S. \_\_\_\_ (2007).

B.) Obviousness Rejections Based on U.S. Patent Publication No. 2003/0204856 (Buxton) in view of U.S. Patent Publication No. 2002/0129375 (“Kim”), U.S. Patent No. 7,254,622 (“Nomura”), and U.S. Patent Publication No. 2006/0156357 (“Lockridge”).

Claims 1-16, 19-21, 23-31, 34-49, 52-54, 58-62, and 64-66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buxton in view of Kim, Nomura, and Lockridge. Applicant respectfully traverses this rejection because the prior art, including Buxton, Kim, Nomura, and Lockridge fail to teach or suggest all elements of the inventions of independent claims 1 and 34.

Independent claim 1 requires, among other things, “each subscriber that requested the distributable content is billed for transmission over the first network but not for transmission over the second network.” Applicant respectfully submits that the prior art, including Buxton, Kim, Nomura, and Lockridge, fails to teach or suggest each required element of independent claim 1.

The Office concedes that Buxton, Kim, and Nomura fail to teach or suggest billing each subscriber requesting the distributable content for transmission of the distributable transmission over a first network but not over a second network. The Office relies on Lockridge to remedy the deficiencies of Buxton, Kim, and Nomura. Lockridge, at paragraph 28, teaches a billing process where a client is charged a fee when the client does not have subscription and the client is not charged a fee when the client has a subscription. Contrary to the Office’s

allegations, Buxton, Kim, Nomura, and Lockridge do not teach or suggest billing each client that requested the content for transmission over a first network but not the second network. Accordingly, Lockridge fails to remedy the deficiency of Buxton, Kim, and Nomura.

Unlike Buxton, Kim, Nomura, and Lockridge, alone and in combination, the invention of independent claim 1 requires, among other things, an interface to a second network communicating with a subscriber that selectively receives the distributable content at a viewing device, where the subscriber is billed for transmission over the first network but not for transmission over the second network. Applicant respectfully submits, Buxton, Kim, Nomura, and Lockridge fail to teach or suggest the invention of independent claim 1. Accordingly, for at least the above reason, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of independent claim 1.

Dependent claims 2-16, 19-21, and 23-31 further define novel features of the invention of independent claim 1 and each depend, either directly or indirectly, from independent claim 1. Accordingly, for at least the reasons set forth above with respect to independent claim 1, dependent claims 2-16, 19-21, and 23-31 are believed to be in condition for allowance by virtue of their dependency. See 37 C.F.R. 1.75(c). As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of dependent claims 2-16, 19-21, and 23-31.

Independent claim 34 requires, among other things, “selectively communicating via a second network the distributable content, wherein the distributable content is configured to expire after a predetermined time, from the content storage to a viewing device associated with a subscriber that receives the distributable content at scheduled times on a pay-per-use basis; and storing the distributable content on a local storage of the viewing device.” Applicant respectfully

submits that the prior art, including Buxton, Kim, Nomura, and Lockridge, fails to teach or suggest the required elements of independent claim 34.

Buxton, Kim, Nomura, and Lockridge each describe video distribution systems. Buxton describes a server that streams movies to an end-user, Kim describes a central office storage that stores popular movie titles, Nomura, describes an online movie rental system, and Lockridge describes a process that converts pay-per-view movies to video-on-demand movies. The prior art, including Buxton, Kim, Nomura, and Lockridge, alone or in combination, fail to teach or suggest a subscriber that receives distributable content—configured to expire after a predetermined time over a second communication at scheduled times on a pay-per-use basis—at a viewing device that has a local storage for storing the distributable content.

Unlike Buxton, Kim, Nomura, and Lockridge, alone and in combination, independent claim 34 requires at least two networks that the distributable content traverses and a viewing device to receive distributable content for the subscriber at scheduled times on a pay-per-use basis. The distributable content is stored on the local storage for the viewing device for viewing or reproduction by the subscriber. Applicant respectfully submits, Buxton, Kim, Nomura, and Lockridge fail to teach or suggest the invention of independent claim 34. Accordingly, for at least the above reason, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of independent claim 34.

Dependent claims 35-49, 52-54, 56-62, and 64-66 further define novel features of the invention of independent claim 34 and each depend, either directly or indirectly, from independent claim 34. Accordingly, for at least the reasons set forth above with respect to independent claim 34, dependent claims 35-49, 52-54, 56-62, and 64-66 are believed to be in condition for allowance by virtue of their dependency. See 37 C.F.R. 1.75(c). As such,

Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of dependent claims 35-49, 52-54, 56-62, and 64-66.

C.) Obviousness Rejections Based on U.S. Patent Publication No. 2003/0204856 (Buxton) in view of U.S. Patent Publication No. 2002/0129375 (“Kim”), U.S. Patent No. 7,254,622 (“Nomura”), U.S. Patent Publication No. 2006/0156357 (“Lockridge”), and U.S. Patent Publication No. 2004/0010717 (“Simec”).

Claims 23, 24, 56, 57, 80-84, 87-89, 91, and 92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buxton in view of Kim, Nomura, Lockridge, and Simec. Applicant respectfully traverses this rejection because the prior art, including Buxton, Kim, Nomura, Lockridge, and Simec fail to teach or suggest all elements of the inventions of independent claims 1, 34 and 80.

Claims 23, 24, 56, and 57 depend from independent claims 1 and 34. As discussed above, Buxton, Kim, Nomura, and Lockridge fail to teach or suggest all the elements of independent claims 1 and 34. Accordingly, claims 23, 24, 56, and 57 are patentable over Buxton, Kim, Nomura, and Lockridge for at least the above-cited reasons. The addition of Simec fails to cure the deficiencies of Buxton, Kim, Nomura, and Lockridge with respect to the elements of independent claims 1 and 34. As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of dependent claims 23, 24, 56, and 57.

Independent claim 80 requires, among other things, “selectively communicating via a second network the distributable content, wherein the distributable content is configured to expire after a predetermined time, from the content storage to a viewing device of a subscriber that receives the distributable content at scheduled times; and activating viewing of the distributable content at the viewing device by a key mechanism.” Applicant respectfully submits



that the prior art, including Buxton, Kim, Nomura, Lockridge, and Simec fail to teach or suggest the required elements of independent claim 80.

Buxton, Kim, Nomura, Lockridge, and Simec each describe video distribution systems. Buxton describes a server that streams movies to an end-user, Kim describes a central office storage that stores popular movie titles, Nomura describes an online movie rental system, Lockridge describes a process that converts pay-per-view movies to video-on-demand movies, and Simec describes a content protection system for rendering multimedia content. The prior art, including Buxton, Kim, Nomura, Lockridge, and Simec alone or in combination, fail to teach or suggest a subscriber that receives distributable content—configured to expire after a predetermined time over a second communication at scheduled times on a pay-per-use basis—at a viewing device that activates the distributable content via a key mechanism.

Unlike Buxton, Kim, Nomura, Lockridge, and Simec, alone and in combination, independent claim 80 requires at least two networks that the distributable content traverses and a viewing device to receive distributable content for the subscriber at scheduled times on a pay-per-use basis. The distributable content is activated by the viewing device for viewing or reproduction by a key mechanism. Applicant respectfully submits, Buxton, Kim, Nomura, Lockridge, and Simec fail to teach or suggest the invention of independent claim 80. Accordingly, for at least the above reason, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of independent claim 80.

Dependent claims 81-84, 87-89, and 91-92 further define novel features of the invention of independent claim 80 and each depend, either directly or indirectly, from independent claim 80. Accordingly, for at least the reasons set forth above with respect to independent claim 80, dependent claims 81-84, 87-89, and 91-92 are believed to be in condition

for allowance by virtue of their dependency. See 37 C.F.R. 1.75(c). As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of dependent claims 81-84, 87-89, and 91-92.

D.) Obviousness Rejections Based on U.S. Patent Publication No. 2003/0204856 (Buxton) in view of U.S. Patent Publication No. 2002/0129375 (“Kim”), U.S. Patent Publication No. 2006/0156357 (“Lockridge”), and U.S. Patent Publication No. 2003/0005454 (“Rodriguez”).

Claims 93-98, 100-102, 104-110, 113-120 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buxton, Kim, Lockridge and Rodriguez. Applicant respectfully traverses this rejection because the prior art, including Buxton, Kim, Lockridge, and Rodriguez, fail to teach or suggest all elements of the inventions of independent claims 93 and 107.

Independent claims 93 requires, among other things, “a content storage interface communicatively connected to a network communicating with a content storage device, the content storage device storing distributable content received from at least one content provider for transmission to a subscriber in a subscriber group, wherein the distributable content is configured to expire after a predetermined number of uses; and a receiver interface communicatively connected to a viewing device having a local storage to store the distributable content, the viewing device is configured to generate a user interface that permits the subscriber to selectively receive the distributable content on a pay-per-use basis and to reproduce a viewable version of the received distributable content, wherein the user interface provides a list of distributable content that is dynamically updated to include popular distributable content based on a number of requests of the popular distributable content received from subscribers in the subscriber group.” Applicant respectfully submits that the prior art, including Buxton, Kim,

Lockridge, and Rodriguez fails to teach or suggest the required elements of independent claim 93.

Buxton, Kim, Lockridge, and Rodriguez each describe video distribution systems. Buxton describes a server that streams movies to an end-user, Kim describes a central office storage that stores popular movie titles, Lockridge describes a process that converts pay-per-view movies to video-on-demand movies, and Rodriguez describes a user interface for purchasing multimedia content. The prior art, including Buxton, Kim, Lockridge, and Rodriguez, alone or in combination, fail to teach or suggest a list of popular distributable provided in a user interface employed by a subscriber to receive distributable content—configured to expire after a predetermined number of uses over a second communication at scheduled times on a pay-per-use basis—and to reproduce viewable versions of the distributable content.

Unlike Buxton, Kim, Lockridge, and Rodriguez, the invention of independent claim 93 requires distributable content that is configured to expire after a predetermined number of uses and a viewing device that receives, stores, and reproduces distributable content on a pay-per-use basis. Buxton, Kim, Lockridge, and Rodriguez, alone and in combination fail to teach or suggests the elements of independent claim 93. Accordingly, for at least the above reason, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 93.

Dependent claims 94-98, 100-102, and 104-106 further define novel features of the invention of independent claims 93, and each depend, either directly or indirectly, from independent claims 93. Accordingly, for at least the reasons set forth above with respect to independent claim 93, dependent claims 94-98, 100-102, and 104-106 are believed to be in condition for allowance by virtue of their dependency. See 37 C.F.R. 1.75(c). As such,

Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claims 94-98, 100-102, and 104-106.

Independent claim 107 requires, among other things, “executing a viewing authorization module to process a key for viewing of the distributable content; and generating an output of the distributable content to view on a viewing device, when the key is validated.” Applicant respectfully submits that the prior art, including Buxton, Kim, Lockridge, and Rodriguez, fails to teach or suggest all required elements of independent claim 107.

Buxton, Kim, Lockridge, and Rodriguez each describe video distribution systems. Buxton describes a server that streams movies to an end-user, Kim describes a central office storage that stores popular movie titles, Lockridge describes a process that converts pay-per-view movies to video-on-demand, and Rodriguez describes a user interface for purchasing multimedia content. The prior art, including Buxton, Kim, Lockridge, and Rodriguez, alone or in combination, fail to teach or suggest a list of popular distributable content provided in a user interface employed by a subscriber to receive distributable content—configured to expire after a predetermined time—and executing a viewing authorization module to process a key for viewing of the distributable content.

Unlike Buxton, Kim, Lockridge, and Rodriguez, the invention of independent claim 107 requires a viewing device that receives and stores distributable content and processes a key for validity prior to generating an output of the distributable content. Buxton, Kim, Lockridge, and Rodriguez, alone and in combination, fail to teach or suggest the elements of independent claim 107. Accordingly, for at least the above reason, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 107.

Dependent claims 108-110 and 113-120 define novel features of the invention of independent claim 107, and each depend, either directly or indirectly, from independent claim 107. Accordingly, for at least the reasons set forth above with respect to independent claim 107, dependent claims 108-110 and 113-120 are believed to be in condition for allowance by virtue of their dependency. See 37 C.F.R. 1.75(c). As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claims 108-110 and 113-120.

E.) Obviousness Rejections Based on U.S. Patent Publication No. 2003/0204856 (Buxton) in view of U.S. Patent Publication No. 2002/0129375 (“Kim”), U.S. Patent Publication No. 2006/0156357 (“Lockridge”), U.S. Patent Publication No. 2003/0005454 (“Rodriguez”), and U.S. Patent No. 7,254,622 (“Nomura”).

Claims 135, 136, 144, 146-148 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buxton, Kim, Lockridge and Rodriguez, and Nomura. Applicant respectfully traverses this rejection because the prior art, including Buxton, Kim, Lockridge and Rodriguez, and Nomura, fail to teach or suggest all elements of the inventions of independent claims 93 and 107.

Independent claim 135 requires, among other things, “connecting to a network communicating with content storage, the content storage storing distributable content received from at least one content provider for transmission to a subscriber, wherein the distributable content is configured to expire after a predetermined number of uses; presenting a user interface to permit the subscriber to selectively receive the distributable content, wherein the user interface provides a list of distributable content that is dynamically updated to include popular distributable content based on a number of requests of the popular distributable content received from subscribers in the subscriber group, presents selectable options to permit the subscriber to

choose to receive the distributable content at selected times on a pay-per-uses basis, presents selectable options to permit the subscriber to choose to receive the distributable content as a background task, and presents a security dialog to receive a key to authorize the subscriber to view the distributable content; and generating an output of the distributable content to view on a viewing device having a locale storage to store the distributable content, wherein reproduction of the distributable content stored in local storage is controlled by a digital rights module.” Applicant respectfully submits that the prior art, including Buxton, Kim, Lockridge, Rodriguez, and Nomura, fails to teach or suggest all required elements of independent claim 135.

Buxton, Kim, Lockridge, Rodriguez, and Nomura each describe video distribution systems. Buxton describes a server that streams movies to an end-user, Kim describes a central office storage that stores popular movie titles, Lockridge describes a process that converts pay-per-view movies to video-on-demand movies, Rodriguez describes a user interface for purchasing multimedia content, and Nomura describes an online movie rental system. The prior art, including Buxton, Kim, Lockridge, Rodriguez, and Nomura, alone or in combination, fail to teach or suggest a list of popular distributable content provided in a user interface employed by a subscriber to receive distributable content—configured to expire after a predetermined number of uses and sent at selected times on a pay-per-use basis—and to execute a security dialog to process a key for viewing of the distributable content and controlling reproduction of the distributable content based on a digital rights module.

Unlike Buxton, Kim, Lockridge, Rodriguez, and Nomura, the invention of independent claim 135 requires distributable content that expires after a predetermined number of uses and a viewing device that generates a user interface to present options to obtain distributable content at selected times on a pay-per uses basis, to present options to receive the

distributable content as a background task, and to present a security dialog to view the distributable content. Also, the viewing device includes a local storage to store the distributable content and to control reproduction of distributable content on the local storage. Buxton, Kim, Lockridge, Rodriguez, and Nomura, alone and in combination, fail to teach or suggest the elements of independent claim 135. Accordingly, for at least the above reason, Applicant respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 135.

Dependent claims 144 and 146-148 define novel features of the invention of independent claims 135, and each depend, either directly or indirectly, from independent claim 135. Accordingly, for at least the reasons set forth above with respect to independent claim 135, dependent claims 144 and 146-148 are believed to be in condition for allowance by virtue of their dependency. See 37 C.F.R. 1.75(c). As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claims 144 and 146-148.

### **CONCLUSION**

For at least the reasons stated above, the pending claims are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

Date: 25 April 2008.

/MONPLAISIR HAMILTON/

---

Monplaisir Hamilton  
Reg. No. 54851

SHOOK, HARDY & BACON L.L.P.  
2555 Grand Blvd.  
Kansas City, MO 64108-2613  
816-474-6550